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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TRESE J. VACKAR

Appeal 2007-3188
Application 10/064,104
Technology Center 3700

Decided: January 25, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Vackar (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-13. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The Appellant's invention is directed to a hair trimming guide constructed from a partial eyeglass frame and an adjustable trim guide attached to the temple pieces for trimming sideburns or the front of the frame for trimming bangs (Spec. ¶ 0013). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A hair trim guide comprising:

an eyeglass frame having a front face frame and a pair of temple pieces attached to and extending rearwardly from said front face frame, each of the pair of temple pieces biased inwardly and having a portion thereof resting upon an ear of a user when said eyeglass frame is positioned for use by said user; and

a trim guide selectively pegged to said eyeglass frame.

¹ Our decision will make reference to Appellant's Amended Appeal Brief ("App. Br.," filed Jun. 17, 2006), Reply Brief ("Reply Br.," filed Apr. 26, 2007), the Examiner's Answer ("Answer," mailed Feb. 26, 2007), and the Final Office Action ("Final," mailed Nov. 17, 2004).

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Miller	4,106,515	Aug. 15, 1978
Benjamin	3,613,694	Oct. 19, 1971
Sessoms	1,385,722	Jul. 26, 1921

THE REJECTION

The following rejections are before us for review:

Claims 1-2 and 8-10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Benjamin in view of Miller.

Claims 3-7 and 11-13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Benjamin in view of Miller as applied to claims 1-2 and 8-10, and further in view of Sessoms.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting claims 1-2 and 8-10 under 35 U.S.C. § 103(a) as unpatentable over Benjamin and Miller and claims 3-7 and 11-13 as unpatentable over Benjamin, Miller, and Sessoms.² This issue turns on whether the prior art discloses a trim

² Only those arguments actually made by Appellant have been considered in this

guide selectively pegged to an eyeglass frame.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Appellant's Specification does not define a "peg" explicitly but element 62 which is called a peg is a cylindrical shaft or rod fixed at one end and at the other end accommodating a receiver or hole as a "peg."
2. For purposes of this appeal a "peg" is a cylindrical shaft or rod fixed at one end and at the other end accommodating a receiver or hole.
3. The agreed to ordinary and customary meaning of "pegged" is "to fasten with a peg." (App. Br. 7 and Final, 5.) Thus, the meaning of "pegged" is to attach by pegs.
4. Benjamin discloses a hair trim guide having an eyeglass frame with a front face (F) and a pair of temple pieces (T) attached to and extending rearwardly from the front face frame (F). Each pair of the temple pieces (T) is biased inwardly and has a portion thereof resting upon an ear of a user when the

decision. Arguments that Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

eyeglass frame is positioned for use (Benjamin, col. 2, ll. 5-6, 9-12, and Fig. 1).

5. Benjamin discloses a trim guide (template 10 or 16). In one embodiment, the trim guide is selectively attached to the eyeglass frame. (Benjamin, col. 2, ll. 19-21 and Figs. 1 and 2).
6. Benjamin discloses multiple ways of selectively attaching the trim guide to the temple pieces (T) to adjust the amount of hair trimming using the guide:
 - a. Plural hooklike portions. (Benjamin, Fig. 1 and col. 2, ll. 21-26).
 - b. Score and cut lines inscribed thereon. (Benjamin, Figs. 3, 7, and col. 2, ll. 36-39 and col. 3, ll. 15-25). Scoring the trim guides causing them to be frangible at the score lines. This permits the trim guide to be adjusted in the horizontal direction and on a bias in order to trim the hair to the desired length.
 - c. Slidable members. (Benjamin, Fig. 4 and col. 2, ll. 58-60.)
7. Miller teaches a cylindrical shaft 24 attached to a frame and projecting therefrom so that the shaft can fit through an aperture (slit 32) of a trim guide (template 28) (Miller, col. 2, ll. 7-23, Fig. 2). As such, Miller's shaft 24 is a peg. Miller's trim guide has measurement indicia along the slotted receiver. (Miller, fig. 3.) The user of the trim guide can select the desired height from the measurement indicia and place the receiver through the taught cylindrical rod. (Miller, col. 2, ll. 7-28 and Figs. 1-3.)

8. Sessoms teaches buttons or protrusions (short shafts) connecting a pair of frames to a guide. (Sessoms, ll. 59-60, Fig. 1.) These protrusions are passed through holes within a guide. (Sessoms, ll. 60-61, Fig. 3.) As such, the protrusions are pegs. When the protrusions are passed-through the holes, the guide is pegged to the frames. (Sessoms, ll. 61-62, Fig. 1.) Sessoms permits selective pegging of the guide to the frames to adjust the guide's height for trimming hair, because there is an array of holes. (Sessoms, ll. 70-82 and 103-107, figs. 1 and 2.)

PRINCIPLES OF LAW

In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.*

The Supreme Court's opinion in *United States v. Adams*, 383 U.S. 39, 40 (1966) is illustrative of the “functional approach” to be taken in cases where the claimed invention is a prior art structure altered by substituting one element in the

structure for another known element. *KSR*, 127 S.Ct. at 1739. “The Court [in *Adams*] recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. 383 U.S., at 50-51.” *Id.* at 1740. Ultimately the *Adams* Court found the combination at issue *not* obvious to those skilled in the art because, although the elements were known in the prior art, they worked together in an *unexpected* manner.

The [*Adams*] Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.*, at 51-52, 86 S.Ct. 708. When Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed. *The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams’s design was not obvious to those skilled in the art.*

KSR, 127 S.Ct. at 1740 (emphasis added).

ANALYSIS

The Appellant argues the patentability of only independent claim 1 for the first ground of rejection. (App. Br. 8-13.) As such, we select claim 1 as the representative claim and claims 2 and 8-10 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The main issue between the Examiner and the Appellant is the interpretation of “peg.” (App. Br. 4-5, Reply Br. 2-3, Answer, 5.) The secondary issue between

the Examiner and Appellant is whether Miller teaches a peg. (App. Br. 5-6, Reply Br. 3-5, Answer, 5.)

The Appellant provides a dictionary definition³ for “peg” and contends the teaching of a screw in Miller cannot be a peg under the proffered dictionary definition. (App. Br. 5, 7-8, and Reply Br. 2-5.) The Appellant’s evidence and contention are not persuasive. The Appellant’s dictionary definition of peg is: a wooden pin for fastening things together or plugging a hole. Element 62 disclosed as a peg in the Specification is not wooden and therefore is not in accord with the dictionary definition. The Specification discloses a cylindrical shaft or rod fixed at one end and at the other end accommodating a receiver or hole as a peg. (Finding of Fact 1.)

The prior art discloses a shaft or rod structure fixed at one end and the other end accommodating a receiver or hole. Miller teaches a cylindrical shaft having threads and a slotted receiver. (Finding of Fact 7.) The receiver is passed-over the shaft and then another receiver (the wing nut) is attached to the shaft to fix the slotted receiver. (Miller, Fig 2.)

In addition, Miller’s trim guide has measurement indicia along the slotted receiver. (Finding of Fact 7.) The user of the trim guide can select the desired height from the measurement indicia and place the receiver through the taught

³ The Appellant provides a dictionary definition of “peg” as “1a. A small cylindrical or tapered pin, *as of wood*, used to fasten things or plug a hole. b. A similar pin forming a projection that may be used as a support or boundary marker.” (Evidence Appendix, App. Br. 14)(emphasis added.)

cylindrical rod. (Finding of Fact 7.) As such, the user can be selective with respect to the attachment of the guide to the frame. Therefore, Miller provides the teaching of a trim guide being “selectively pegged” to a frame in order to trim hair to the desired length.

In addition, Sessoms teaches buttons or protrusions (short shafts) connecting a pair of frames to a guide. (Finding of Fact 8.) These protrusions are passed through holes within a guide. (Finding of Fact 8.) When the protrusions are passed-through the holes, the guide is pegged to the frames. (Finding of Fact 8.) Sessoms discloses selective pegging of the guide to the frames to adjust the guide’s height for trimming hair, because there is an array of holes. (Finding of Fact 5.)

We are not persuaded by Appellant’s argument that modifying Miller would destroy the intended purpose of Miller. (App. Br. 6.) The Examiner is proposing to modify Benjamin and not Miller. Thus, the Appellant contention is not persuasive because it does not properly address the Examiner proposed modification of Benjamin by Miller, but instead address a modification not proposed by the Examiner (Miller by Benjamin).

For the reasons provided *supra*, the Appellant has not shown that the Examiner erred in rejecting claim 1.

Appellant argues dependent claims 3-7 and 11-13 as a group, relies on the previous arguments directed to claim 1, and argues that the additional teaching of Sessoms does not correct the deficiencies of Benjamin and Miller. (App. Br. 8-9.) Finding no deficiencies in the combination of Benjamin and Miller, we sustain the

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rejection of dependent claims 3-7 and 11-13 as being unpatentable over Benjamin, Miller, and Sessoms for the same reasons provided *supra* for claim 1.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1-13.

DECISION

The decision of the Examiner to reject claims 1-13 is affirmed.

AFFIRMED

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